

## **REMARKS**

Reconsideration of this application and allowance of the claims is respectfully requested.

It is believed that the amendments to the claims are all clearly supported by the disclosure of this application.

Limitations of claim 5 have been inserted into claim 1.

In the final rejection of July 18, 2003, the examiner has rejected claims 1-4 and 8-11 as being unpatentable over Walker et al. U.S. Patent No. 6,068,552, in view of Pease et al. U.S. Patent No. 5,326,104.

We have already argued that Walker teaches away from the concept of claim 1, since in Walker it is the player who modifies the paytables and not the gaming operator. The examiner rebuts this with basically the opinion that (page 8 of the Office Action) "...it would have been obvious to one of ordinary skill in the art to utilize the hardware and software components of Walker with an added security feature of only allowing gaming operators access to the game customization."

This, of course, overrides the purpose of Walker in a manner that is questionable, because it has been frequently held by the Courts and the PTO Board of Appeals that combinations of references must not be entirely arbitrary, but there must be a reason for the combination present in the combined references.

Furthermore, claim 1, as amended, calls for a method in which the first overall payback percentage for the first payable is different from the second, overall payback percentage of the stored payable. The support for this is clear. See Fig. 4, for example, in which various overall payback percentages are provided for selection by the gaming operator (i.e., the manager, not the players).

To the contrary, Walker et al. is clearly a system in which the overall payback percentage is intended to be constant, and that is a clear object of the invention. The term is as used in Walker et al. is “house advantage”, which is, of course, substantially the same concept as the “overall payback percentage” as found in the specification and claims of this application. In support of this, see, in Walker et al., column 2, line 16; column 5, lines 52 and 53; column 7, line 57, and column 9, lines 32-34. Thus, while the program in Walker et al. may be adjusted by the players in various ways, the house advantage remains constant. To the contrary, in this invention, and as called for in claim 1, a change in the program payable is provided in which the “first overall payback percentage” (a similar concept to “house advantage”) is different from the second overall payback percentage.

Accordingly, it is submitted that those skilled in the art would fail to find the invention of this application obvious from any combination of Walker et al. in view of Pease et al. Not only does claim 1 and its dependent claims contemplate a method for configuring a payable in which the overall payback percentage (and thus the house advantage) is modified, not by a game player but by the game manager, and a method is provided which is for managers, excluding use by the game players, both distinctions being contrary to Walker et al. The fact that Pease et al. relates to security systems for gaming machines fails to overcome these distinctions of the combined prior art from the invention as defined in Claim 1 and its dependent claims.

The hypothetical combination that the examiner proposes would necessarily comprise a system in which it is the players who can modify the program in various ways. Also, as called for in claim 1, the method requires a change in the payback

percentage, as selected by the gaming operator, contrary to that which is taught in Walker et al.

Accordingly, it is submitted that claim 1 and its dependent claims are not rendered obvious by the addition of general concepts relative to security systems as taught in Pease et al., applied in some unspecified way to Walker et al., which carries the significant distinctions from claim 1 as described above.

Claims 23-25 have been rejected by the examiner as unpatentable over Walker et al. in view of Regulation 14 of the Nevada Gaming Statutes.

While Walker et al. does deal with changes in a payable, as previously discussed, the changes contemplated by Walker are made by the players of the game, not the "gaming operator". Claim 23, by amendment, clearly states that it is the gaming operator that is making the changes, providing a first distinction of claim 23 and its dependent claims from the examiner's combined rejection.

The examiner also states, on page 4 of the last Office Action, "It is inherent to the game that the newly customized payable is prevented from being used until all calculations are preformed, thereby gaining regulatory approval and user approval since every gaming terminal payable requires approval from a regulatory agency."

Applicant's attorney disagrees with this statement. It is true that the newly customized payable should not be used until all the calculations are performed. However, normally there is nothing actively, physically, preventing such use. Here is where the invention of claim 23 finds further distinction over the combination of Walker et al. in view of regulation 14. By the method of claim 23, the payable change is

actively, electronically prevented from being used until "...information is input to said gaming terminal confirming regulatory approval."

By the method of claim 23 and its dependent claims, accidental use of an unauthorized, illegal payable change may be automatically, electronically prevented from use until confirmation of regulatory approval is provided, typically by electronic means, to the system. Thus, potential liability for the proprietors of gaming machines can be avoided, in a generally automated, electronic manner.

When one reviews Walker et al. in view of Regulation 14, there is nothing of this suggested. Regulation 14 merely states what should and should not be done. Walker et al. teaches a method where game players, not game operators, can change the payable. An important feature of claim 23 is thus missing: the requirement of a method, typically performed electronically, which prevents use of the payable change until information is input to the gaming terminal confirming regulatory approval. This information preferably is contained in the third information, which is transmitted from a regulatory agency computer to the gaming terminal, so that such approval is fully automated.

As previously stated, this concept is simply absent from the combination of Walker et al. and Regulation 14, nor is there any inherency of such combination. If this concept were "inherent", then it might also be argued that it would be inherent to have a mechanism where automobiles will not start until it is electronically confirmed from a Bureau of Motor Vehicles computer that the license fees have been paid. That, of course, may be an invention yet to be invented, but here in the field of gaming

machines, a clearly non-inherent improvement over any combination of Walker et al. in view of Regulation 14 has been provided by claim 23 and its dependent claims.

The examiner has also rejected claims 5-7 as being unpatentable over Walker et al. in view of Pease et al. and in further view of VanHuben et al. U.S. Patent No. 5,878,408.

As the examiner states, VanHuben et al. fails to specifically state that a message is put out if results fail to comply with the gaming criteria, but VanHuben et al. teaches criteria checks generally as part of computer programming.

It is submitted that the limitations of claim 1 previously discussed provide patentable distinction over these claims, which have a chain of dependency extending to claim 1. Claims 5-7 provide further specificity and distinction over the combined references raised by the examiner in the rejection.

In view of the above, allowance of the claims is respectfully requested.

Respectfully submitted,  
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